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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,817	02/27/2004	John G. Babish	068911-0074	5656
23630 7590 04/30/2010 McDermott Will & Emery 600 13th Street, NW Washington, DC 20005-3096				
EXAMINER CARTER, KINDRA D				
ART UNIT		PAPER NUMBER		
1627				
NOTIFICATION DATE		DELIVERY MODE		
04/30/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mweipdocket@mwe.com

Office Action Summary

Application No.

10/789,817

Applicant(s)

BABISH ET AL.

Examiner

KENDRA D. CARTER

Art Unit

1627

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6,7,9 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6,7,9 and 11-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/21/10
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The Examiner acknowledges the applicant's remarks and arguments of January 21, 2010 made to the office action filed July 22, 2009. Claims 1, 2, 4, 6, 7, 9 and 11-15 are pending. Claims 1, 2, 4, 6 and 11-13 are amended and claims 3, 5, 8, 10 and 16-32 are cancelled.

In light of the terminal disclaimer filed January 21, 2010 over application 10/590,424 the obviousness-type double patenting rejection is withdrawn.

In light of the claim amendments the 35 USC 103(a) rejection of claims 1-7, 9 and 11-15 is withdrawn.

Due to the amendment to the claims, the new 35 USC 103(a) rejection is below. In light of the new rejection the Applicant's arguments are moot. The Examiner would like to note that the claims are still not commensurate to scope of the "synergistic" results demonstrated in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramirez (US 2002/0102345 A1) in view of Todd, Jr. et al. (US 5,041,300).

Ramirez teaches a beverage composition (i.e. oral and inherently possess a pharmaceutically acceptable carrier; addresses claims 14 and 15) comprising beer (see page 2, paragraph 29, line 3 and claim 1) and caffeine (see page 6, paragraphs 85-91 and claim 13; addresses claim 1, 7 and 9). Once the base composition is provided, special ingredients may then be incorporated into the liquid in such quantities and relative proportions that help enhance the body's alertness and energy sensation (see page 6, paragraph 82).

Ramirez does not teach a reduced isoalpha acid (RIAA), such as dihydroisohumulone either derived or not derived from hops as disclosed in claims 1, 2, 4 and 6, nor the amounts of the compound nor ratio to the methylxanthine as disclosed in claims 1, 9 and 11-13.

Todd, Jr. et al. teach a hop derived flavor such as dihydroisohumulone (see claim 4) for post-fermentation flavoring of beer. The purified flavor provides a non-

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objectionable-aroma-forming hop flavor (see column 2, lines 25-39 and column 6, lines 35-40). Todd Jr. et al. found that the composition has a more reproducible and acceptable flavoring and aroma (see claim 7).

To one of ordinary skill in the art at the time of the invention would have found it obvious and motivated to combine the composition of Ramierz and the reduced isoalpha acid (RIAA) dihydro-isohumulone because Todd Jr, et al. teach that dihydro-isohumulone provides non-objectionable-aroma-forming hop flavor for post-fermentation beer. Thus, in the brewing of the Ramierz beer, one skilled in the art would be motivated to add dihydro-isohumulone to give a non-objectionable-aroma-forming hop flavor to the beverage.

To one of ordinary skill in the art at the time of the invention would have found it obvious and motivated to combine the composition of Ramierz in view of Todd Jr. et al. and the amounts of the dihydro-isohumulone and methylxanthine as well as the ratio between the two compounds as disclosed in claims 1, 9 and 11-13 because one skilled in the art would be able to adjust the amounts of these compounds in order to provide the desired effect of aroma and flavor (dihydro-isohumulone) and energy boost (methylxanthine; caffeine). Ramiez teaches that once the base composition is provided, special ingredients may then be incorporated into the liquid in such quantities and relative proportions that help enhance the body's alertness and energy sensation (see page 6, paragraph 82).

In regards to the use of the composition claimed for the treatment of inflammation and the composition having "anti-inflammatory" synergistic amounts, the intended use does not get patentable weight. The reason for combining the prior art does not have to be the same as the Applicant. The claims are examined on the merits of a composition and not a method for treatment of inflammation.

In regards to methylxanthine and tetra-hydroisoalpha acids being in synergistic amounts, Ramierz in view of Todd Jr. et al. teach a synergistic amounts because Todd Jr. et al. teach that dihydro-isohumulone are manufactured and purified from hops to provide better flavor. Thus, by adding dihydro-isohumulone, the composition has a more reproducible and acceptable flavoring and aroma (see Todd, Jr. et al., claim 7).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KENDRA D. CARTER whose telephone number is (571)272-9034. The examiner can normally be reached on 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kendra D Carter/
Examiner, Art Unit 1627

/SREENI PADMANABHAN/
Supervisory Patent Examiner, Art Unit 1627